

TETZLAFF, Patrick C.

S/N 09/559,867

diaphragm assembly, classified in class 73, subclass 119R; Group II (claims 9-20), drawn to an exhaust gas pressure sensing system, classified in class 73, subclass 118.1; and Group III (claims 37-46), drawn to an engine, classified in class 73, subclass 116. Responsive thereto, Applicant elects Group 1, claims 1-8, 21-23, 24-36, and 47-57, with traverse, for prosecution in the present case.

REMARKS

Responsive to the Office Action mailed June 18, 2002, Applicant has elected claims 1-8, 21-23, 24-36, and 47-57 for prosecution in the present case, but, nevertheless, believes that the Examiner's issuance of a Restriction Requirement was in error and is hereby traversed.

In requiring an election, the Examiner asserts that the three groups of inventions are distinct because they "are related as subcombinations disclosed as usable together in a single combination." The Examiner suggests that "invention I does not require a probe for being secured to the marine engine and configures to extend into the engine exhaust path as specified in invention II."

However, Claim 22 of Group I calls for coupling an inlet of the diaphragm assembly in flow communication with an exhaust path of an engine and includes partially inserting a probe through an opening in the engine, securing the probe in place, and engaging one end of a tube to the probe. As called for in claim 22, of Group I, a probe is required for securing the invention of Group I to a marine engine. Therefore, restriction is improper for this reason alone.

The Examiner also suggests that Group I does not require a powerhead as illustrated in Group III. Claim 21 of Group I claims a method for securing a diaphragm assembly to an engine comprising a step of coupling an inlet of the diaphragm assembly in flow communication with an exhaust path of the engine. As is known by those skilled in the art, the term "powerhead" includes an engine and is commonly used to describe an arrangement that includes an internal combustion engine of an outboard.

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Moreover, although the Examiner states that "In the instant case, invention I does not require a probe for being secured to the marine engine and configures to extend into the engine exhaust path as specified in invention II, or a powerhead as illustrated in invention III," however, the Examiner's grouping of the claims not only does not warrant restriction, it is opposed to the Examiner's own argument. For example, claim 24 (Group I) specifies an engine (allegedly of Group III) and dependent claim 28 (Group I) calls for a probe means (allegedly of Group II) and claim 28 (Group I) further positions the probe within an exhaust path of the *engine*. Claim 29 (Group I) further defines the probe means and dependent claim 35 (Group I) further defines the configuration of the probe means in the engine with respect to an engine engagement assembly. The Examiner grouped claims 24-36 in Group I and therefore the Examiner's statement that Group I does not require a probe secured to an engine is simply incorrect. To properly examine Group I, which includes claims 24-36, the Examiner must search the diaphragm, the probe, and the engine utilizing the probe and the diaphragm.

Claims 47-57 were also included in Group I and independent claim 47 specifically calls for a kit for a marine engine. Claim 52, which depends from claim 47 (Group I), adds "a probe for being secured to the marine engine..." Applicant is thereby confused by the Examiner's statement that Group I "does not require a probe for being secured to the marine engine." This is the exact configuration called for in claim 52 — of Group I.

For the reasons set forth above, the Restriction Requirement presented by the Examiner is not sustainable. The diaphragm assembly called for in claim 1 can be used with the probe, and such a combination is called for in independent claim 9. However, the probe is also an element of Group I in various dependent claims as specified above. As one skilled in the art would readily recognize, the probe and the diaphragm are preferably implemented in an engine configuration. The Examiner has not shown that the alleged subcombinations are distinct from each other and has given no valid reason to justify a Restriction Requirement. As outlined above, Group I includes not only the diaphragm, as called for in

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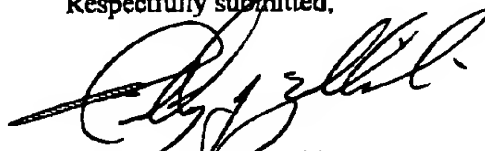
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claim 1, but also includes the probe and the engine, as called for various dependent claims of Group I. Accordingly, Applicant requests for rejoinder of claims 1-57 and the withdrawal of the Restriction Requirement.

The Examiner also suggests that restriction is required because the search required for Group I is not required for Groups II and III. Applicant believes that since Group I requires a probe and a powerhead as discussed above, the search for Group I claims should properly also require a search for Group II and Group III claims.

Reconsideration and removal of the Restriction Requirement is respectfully requested because the Applicant believes that the search and examination of the entire application can be made without serious burden. Under such conditions, it is respectfully submitted that the official Patent Office policy is to encourage the Examiner to examine the entire application on the merits. MPEP §803. Should the Examiner have any questions regarding this Response, he is invited to call the undersigned at his direct dial no. 414- 227-1204.

Respectfully submitted,



Timothy J. Ziezkowski
Registration No. 38,368
Direct Dial (414) 227-1204
Fax: 414-271-2840
tjz@cf-law.com

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P.O. ADDRESS:
Cook & Franke, S.C.
660 East Mason Street
Milwaukee, WI 53202
(414) 271-5900